

Remarks

Upon entry of the foregoing amendment, claims 1-2, 2-11, 13-15, 17-28, 31-33, 66, and 69-82 are pending in the application, with claims 1-2, 21, 23, and 66 being the independent claims. Based on the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1-2, 2-11, 13-15, 17-20, 23-28, 31-33, 66, and 69-82 were rejected as being anticipated by U.S. Patent 5,939,301. Applicants respectfully traverse.

“When a prior U.S. patent, U.S. patent application publication, or international application publication is not a statutory bar, a **35 U.S.C. 102(e)** rejection can be overcome by... submitting an affidavit or declaration under **37 CFR 1.132** establishing that the relevant disclosure is applicant's own work.” *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969). See MPEP § 2136.05. The MPEP goes on to say:

“[w]hen the unclaimed subject matter of a reference is applicant's own invention, applicant may overcome a *prima facie* case based on the patent ... by showing that the disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee ... was associated with applicant (e.g. worked for the same company) and learned of applicant's invention from applicant”. Id., citing *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969).

Applicants have filed concurrently herewith a declaration under **37 CFR 1.132** to show that U.S. Patent 5,939,301 is applicant's own previous work. The cited reference names Deb Chatterjee and John Hughes as inventors. The present application also names Deb Chatterjee as an inventor, in addition to Joseph Solus and Shuwei Yang. Deb Chatterjee has averred in his declaration that he “directed fellow LTI researchers John

Hughes, Joseph Solus, and Shuwei Yang in efforts to produce and characterize mutant DNA polymerases and to develop assays using mutant DNA polymerases as described in U.S. Patent Application No. 09/891,332 and U.S. Patent No. 5,939,301.” Because inventor Deb Chaterjee supervised the work described in both the present application and the cited patent, the requirements of MPEP § 2136.05 and *In re Matthews* have been satisfied. The work disclosed in the cited patent reference is applicant’s own work, and the present claims therefore cannot be anticipated by this patent. Applicants respectfully request that the rejection under 35 USC § 102(e) be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

Date: May 2, 2007

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